

REMARKS/ARGUMENTS

I. General Remarks.

Applicants respectfully request that the Examiner reconsider the application in view of the following remarks.

II. Disposition of the Claims.

At the time of the Office Action, Claims 1, 2, 4, 5, 9, 10, 12-14, 16, 17, 21, 22 and 24-40 were pending in the application. Claims 1, 2, 4, 5, 9, 10, 12-14, 16, 17, 21, 22 and 24-40 were rejected. Claims 1, 13, 16, 17, 25, 31, and 33 have been amended. Claims 10, 22, 30, and 38 have been canceled without prejudice or disclaimer.

III. Remarks Regarding Rejections Under 35 U.S.C. § 112

A. Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 Satisfy the Written Description Requirement of 35 U.S.C. § 112.

Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. According to the Examiner, the specification does not support the limitation “about 35% to about 95% by volume water.” Applicants respectfully traverse these rejections for the reasons discussed below.

“To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.” *Manual of Patent Examining Procedure* § 2163(I) (2004) (hereinafter “MPEP”). “The examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims.” MPEP 2163(II)(A)(3)(b). Merely arguing lack of literal support in the disclosure is not sufficient to satisfy the Examiner’s burden. *In re Wertheim*, 541 F.2d 257, 265 (CCPA 1976) (“The PTO has done nothing more than argue lack of literal support, which is not enough.”).

The Examiner has not met the burden of providing why a person of ordinary skill in the art would not recognize in the original disclosure a description of “from about 35% to about 95% by volume water,” when a broader range is disclosed. As the Examiner states, the specification

explicitly discloses water in the amount from about 10% to about 95% by volume. *See* Office Action, p. 2. Accordingly, there is clearly support in the disclosure for the range of “from about 35% to about 95% by volume water” from the broader disclosure of from about 10% to about 95% by volume.

The Examiner’s only support for this rejection is that the claimed range lacks literal support in Applicants’ disclosure. *See* Office Action at 2. However, merely arguing lack of literal support in the disclosure is not sufficient to satisfy the Examiner’s burden. *In re Wertheim*, 541 F.2d at 257. The claimed invention does not have to be described word for word in order to satisfy the written description requirement of § 112. *Id.* “The burden of showing that the claimed invention is not described in the specification rests on the PTO in the first instance, and it is up to the PTO to give reasons why a description not in *ipsis verbis* is insufficient.” *Id.* Accordingly, the Examiner’s mere statement that there is not literal support for the claimed range is insufficient to support this § 112 rejection for failure to comply with the written description requirement.

Furthermore, several court cases with respect to ranges have found that the written description may support a range that is not expressly disclosed therein. For example, the Federal Circuit, in *Ralston Purina Company v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575-77 (Fed. Cir. 1985), affirmed a district court’s finding that an open ended range was supported by a written description disclosing only a specific range. The Federal Circuit stated:

With respect to protein content, Far-Mar-Co argues that the claim language “protein content of at least about that of solvent extracted soybean meal” is not supported by the language of the parent application, which speaks of “soybean meal having a low fat and high protein content.” The parent application also states that “[s]uch 50% protein soybean meal is well known and frequently is a by-product of the process of oil extraction from soybeans. Such meal is preferably solvent extracted to decrease the fat content thereof to the range mentioned above.” Further, “[s]oybean meal having a protein content of approximately 50% is the preferred meal component for use in the present invention. When, however, the meal has a protein content of substantially less than 50%, it may be mixed with a high protein component which will increase the protein content of the combination to the preferred 50%. The trial court found that the parent disclosure does support the claim language, based on the 1964 disclosure and on consideration of the knowledge possessed by those skilled in the art of extrusion of . . .

vegetable materials in 1964. . . . Having considered Far-Mar-Co's arguments, we conclude that the court did not clearly err in determining that the parent's disclosure adequately supports the protein content of the claims in issue.

Ralston Purina, 772 F.2d at 1575-76.

Likewise, in *Wertheim*, the Court of Customs and Patent Appeals found that a claim amendment to a range of "35-60% solids content" to be included within a range found in the disclosure of "25-60%." See *In re Wertheim*, 541 F.2d at 257. The court explained that the written description requirement does not require that the claim language recite the exact verbiage as found in the disclosure explaining as follows:

[I]n light of the description of the invention as employing solids contents within the range of 25-60% along with specific embodiments of 36% and 50%, we are of the opinion that, as a factual matter, persons skilled in the art would consider processes employing a 35-60% solids content range to be part of the appellants' invention and would be led by the Swiss disclosure so to conclude. Cf. *In re Ruschig*, *supra*. The PTO has done nothing more than to argue lack of literal support which is not enough. If lack of literal support alone were enough to support a rejection under § 112, then the statement of *In re Lukach*, *supra*, 58 CCPA at 1235, 442, F.2d at 969, 169 USPQ at 796, that "the invention claimed does not have to be described in *ipsis verbis* in order to satisfy the description requirement of § 112," is empty verbiage. The burden of showing that the claimed invention is not described in the specification rests on the PTO in the first instance, and it is up to the PTO to give reasons why a description not in *ipsis verbis* is insufficient.

In re Wertheim, 541 F.2d at 257. Accordingly, Applicants' broader disclosure supports the claimed range of "from about 35% to about 95% by volume water."

For the foregoing reasons, the Examiner has not met the initial burden of presenting evidence or reasoning to support the § 112 rejection. For at least this reason, the § 112 rejection of Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 is improper. As such, Applicants respectfully request that the § 112 rejections of Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 be withdrawn.

IV. Remarks Regarding Rejections Under 35 U.S.C. § 102.

A. Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 are not Anticipated by the *Horn* Reference.

Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,529,887 issued to Horn et al ("*Horn*"). Applicants respectfully traverse these rejections for the reasons discussed below.

In order to establish a *prima facie* case of anticipation, all the elements of the claimed invention must be found within a single prior art reference. *Dewey & Almy Chemical Co. v. Mimex*, 124 F.2d 986, 52 USPQ 138 (2d Cir. 1942). Applicants respectfully submit that each and every element of Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 is not found within the *Horn* reference.

Claim 1, as amended, recites:

A method of removing an epoxy-based resin coating from a surface comprising applying a cleaning solution comprising a pH-adjusting agent, a solvent, and from about 35% to about 95% by volume water to a surface at least partially coated with an epoxy-based resin, wherein the solvent is selected from the group consisting of dipropylene glycol monomethyl ether, diethylene glycol monomethyl ether, and combinations thereof.

Applicants respectfully submit the *Horn* reference fails to teach, suggest, or disclose each of these elements. For example, *Horn* fails to teach, suggest, or disclose a solvent "selected from the group consisting of dipropylene glycol monomethyl ether, diethylene glycol monomethyl ether, and combinations thereof." Instead, the portion of *Horn* relied upon by the Examiner discloses a solution consisting of water, KOH, diethylene glycol monoethyl ether, ethylene glycol monobutyl ether, and KF. See col. 5, ll. 18-28. None of these components are a solvent "selected from the group consisting of dipropylene glycol monomethyl ether, diethylene glycol monomethyl ether, and combinations thereof." For at least this reason, the rejection of Claim 1 is improper. Therefore, Applicants respectfully request that the rejection of Claim 1 be withdrawn.

As amended, Claims 13, 25, and 33 also recite a solvent "selected from the group consisting of dipropylene glycol monomethyl ether, diethylene glycol monomethyl ether, and combinations thereof." Therefore, Applicants submit that Claims 13, 25, and 33 are allowable,

for example, for reasons similar to those discussed above with regard to Claim 1. As such, Applicants respectfully request that the rejections of Claims 13, 25, and 33 be withdrawn.

Claims 2, 4, 5, 9, 12, 14, 16, 17, 21, 24, 26-29, 31, 32, 34-37, 39, and 40 depend from Claims 1, 13, 25, and 33. Therefore, Applicants submit that Claims 2, 4, 5, 9, 12, 14, 16, 17, 21, 24, 26-29, 31, 32, 34-37, 39, and 40 are allowable, for example, for reasons similar to those discussed above with regard to Claims 1, 13, 25, and 33. As such, Applicants respectfully request that the rejections of Claims 2, 4, 5, 9, 12, 14, 16, 17, 21, 24, 26-29, 31, 32, 34-37, 39, and 40 be withdrawn.

B. Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, and 24 are not Anticipated by the *Nakayama* Reference.

Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, and 24 were also rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,197,124 issued to Nakayama ("*Nakayama*"). Applicants respectfully traverse these rejections for the reasons discussed below.

As discussed above, in order to establish a *prima facie* case of anticipation, all the elements of the claimed invention must be found within a single prior art reference. *Dewey & Almy Chemical Co. v. Mimex*, 124 F.2d 986, 52 USPQ 138 (2d Cir. 1942). Applicants respectfully submit that each and every element of Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, and 24 is not found within the *Nakayama* reference.

Claim 1, as amended, recites:

A method of removing an epoxy-based resin coating from a surface comprising applying a cleaning solution comprising a pH-adjusting agent, a solvent, and from about 35% to about 95% by volume water to a surface at least partially coated with an epoxy-based resin, wherein the solvent is selected from the group consisting of dipropylene glycol monomethyl ether, diethylene glycol monomethyl ether, and combinations thereof.

Applicants respectfully submit the *Nakayama* reference fails to teach, suggest, or disclose each of these elements. For example, *Nakayama* fails to teach, suggest, or disclose a solvent "selected from the group consisting of dipropylene glycol monomethyl ether, diethylene glycol monomethyl ether, and combinations thereof." Instead, *Nakayama*

Claim 13 also recites a solvent “selected from the group consisting of dipropylene glycol monomethyl ether, diethylene glycol monomethyl ether, and combinations thereof.” Therefore, Applicants submit that Claim 13 is allowable, for example, for reasons similar to those discussed above with regard to Claim 1. As such, Applicants respectfully request that the rejection of Claim 13 be withdrawn.

Claims 2, 4, 5, 9, 12, 14, 16, 17, 21, and 24 depend from Claims 1 and 13. Therefore, Applicants submit that Claims 2, 4, 5, 9, 12, 14, 16, 17, 21, and 24 are allowable, for example, for reasons similar to those discussed above with regard to Claims 1 and 13. As such, Applicants respectfully request that the rejections of Claims 2, 4, 5, 9, 12, 14, 16, 17, 21, and 24 be withdrawn.

SUMMARY

In light of the above remarks and amendments, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants believe no fee is due in association with the filing of this Amendment and Response. However, should the Commissioner deem that any fees are due, including any fees for extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition Therefor, and direct that any additional fees also be charged to Deposit Account No. 08-0300 (Reference Number 2003-IP-012125U1).

Respectfully submitted,



Robert A. Kent
Registration No. 28,626
Halliburton Energy Services, Inc.
2600 South Second Street
P.O. Drawer 1431
Duncan, OK 73536-0440
Telephone: 580-251-3125

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